

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	APOSTOLOPOULOS, et al.	Patent Application
Application No.:	09/899,622	Group Art Unit: 2145
Filed:	July 3, 2001	Examiner: Hossain, T.
For:	METHOD AND SYSTEM FOR DELIVERING STREAMING MEDIA TO FIXED CLIENTS OR MOBILE CLIENTS WITH MULTIPLE DESCRIPTION BITSTREAMS	

REPLY BRIEF

In response to the Examiner's Answer mailed on February 8, 2008, Appellants respectfully submit the following remarks.

REMARKS

Appellants are submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellants are addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellants agree with the other arguments presented in the Examiner's Answer.

1. Response to Assertion that Motivation Exists to Combine Wang with Kroon

On Page 13 of the Examiner's Answer, it is asserted that "it would have been obvious to one of ordinary skill in the art at the time of the invention to envision further efficiency within the system" (emphasis added; page 13, lines 3-4) and "[t]o one of ordinary skill in the art, it would have been completely obvious to substitute this concept into system of Kroon, because Wang is from the same field of endeavor, because efficiency would be improved in Kroon by including the concept, because the concept was in use in the art of media streaming, and because Wang explicitly discloses the very same concept as claimed and the merits thereof" (emphasis added; page 13, lines 16-20).

Appellants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP § 2131.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Appellants respectfully submit that combining the teachings of Kroon and Wang in the manner suggested would not improve the efficiency of the system of Kroon, as asserted. For example, modifying the C-representation of Kroon such that the "C-representation is not required to recover audible signals" as asserted would increase the size of the C-representation, and add inefficiencies into

the system. Therefore, in combination with the arguments presented in the Appeal Brief, Appellants respectfully maintain that by disclosing that only the C-representation is independently decodable, and that the enhancement information is not independently viable, Kroon teaches away from the suggested modification and combination with Wang.

2. Response to Application of *KSR*

Appellants note that the instant Appeal Brief was filed August 13, 2008. While the Supreme Court ruling in *KSR* was published April 30, 2007, the Manual of Patent Examining Procedure (MPEP) was not updated until September 2007 to reflect the *KSR* decision. Appellants respectfully submit that while *KSR* was not specifically referenced in the Appeal Brief, the arguments presented are consistent with the holding of *KSR*.

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)). Appellants note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141(III)).

In particular, Appellants respectfully submit that *KSR* did not overturn the prior holding that “[i]t is improper to combine references where the references teach away from their combination” (emphasis added; MPEP 2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Furthermore, Appellants submit that *KSR* did not overturn the prior holding that “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Moreover, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed amendment” (emphasis added) (MPEP § 2143.01).

Therefore, Appellants respectfully maintain that the arguments presented in the Appeal Brief regarding the lack of motivation to combine the references due to the references teaching away from the asserted combinations, the proposed modifications changing the principle of operation of the prior art, and the proposed modification rendering the prior art being modified unsatisfactory for its intended purpose are proper arguments in light of *KSR*, and the Appellants respectfully maintain the arguments presented in the Appeal Brief.

CONCLUSION

In view of the above remarks, Appellants continue to assert that pending Claims 1, 2, 4-6, 9, 11, 13-15 and 18 are patentable over the combination of Kroon, Wang and Ehrman, that pending Claims 7, 8, 10, 16, 17 and 19 are patentable over the combination of Kroon, Wang, Ehrman and Gershman, that pending Claims 20-22 are patentable over the combination of Kroon, Wang, Ehrman and Krueger, and that pending Claims 23-26 are patentable over the combination of Kroon, Wang, Ehrman, Krueger and Gershman, for reasons presented above and for reasons previously presented in the Appeal Brief.

Respectfully submitted,

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